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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,628	01/28/2004	Debra L. Harp	FIREPLACE	3748

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EXAMINER

PRICE, CARL D

ART UNIT PAPER NUMBER

3749

DATE MAILED: 04/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/766,628	Applicant(s) HARP ET AL.	
	Examiner CARL D. PRICE	Art Unit 3749	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/27/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-6 and 8-20 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that the prior art relied on by the examiner in the last office action fails to show the invention as set forth in the claims of the present application. In particular, applicant suggests the prior art does not have a "light and image reflective material" with a "viewable surface having an angle of incidence and an angle of reflection which are both substantially equal as viewed by a viewer of the system".

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 10-20: Rejected under 35 U.S.C. 102(b)

Claims 1-6 and 10-20 are rejected under 35 U.S.C. 102(b) as being anticipated by US005469839 (KASULIS et al)(of record).

With regard to claims 1-6 and 10-20, the recitations "A firelight" and "for use within a fireplace" have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Also, with regard to claims 1-6 and 10-20, the phrase "measured to substantially fit within, and couple to, one or more interior surfaces of the fireplace" is deemed a recitation of intended use and as such fails to impart any a positive structural limitation(s) which would distinguish the claimed invention over the prior art of record. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as

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compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

US005469839 (KASULIS et al) shows and discloses a firelight reflective system for use within a fireplace comprising:

- at least one high temperature mirrored glass light or image reflective material having a viewable surface and a coupling surface, the viewable surface having an angle of incidence and an angle of reflection which are both substantially equal as viewed by a viewer of the systems the system measured to substantially fit within, and couple to, one or more interior surfaces of the fireplace; and
- coupling surfaces (for example, 60, 90).

US005469839 (KASULIS et al) discloses the following (see column 5, lines 58- column 6, line 8):

(10) In the embodiment shown in FIGS. 8 and 9, the reflector assembly 74 is fabricated of a plurality of separate components. Such components include a vertical reflector 76 positioned at the rear of the fireplace above that is an angled reflector 78. Such reflectors have downturned edges 80 with apertures 82 for coupling with additional component elements and the interior faces of the side walls of the fireplace.

(11) The next adjacent components are the side reflectors 86. Two similarly shaped side reflectors are utilized. Such reflectors are rectangular in configuration except at one interior corner edge 88 wherein an angle is formed to accommodate the angled reflector 78 at the back of the fireplace. In addition, apertures 90 are formed in the side plates for coupling with the interior side spaces of the fireplace as well as the apertures 82 in the edges of the back and angled reflector plates. FIG. 9 is an enlarged perspective showing of one of the apertures 90 in plate 86 as illustrative of the way coupling may be effected through screws 92.

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With regard to claims 1-6 and 10-20, applicant's attention is directed to Figure 8 of the prior art reference US005469839 (KASULIS et al)(of record) which clearly illustrates a glass mirrored material having both image and light reflective characteristics where, for example, an image of a burning log set (94) and an image of the flames (at 78) are located within the vertical surfaces (76, 78, 86) and presented by the reflective material to a viewer at least in a location oriented according to the perspective represented in figure 8 of US005469839 (KASULIS et al). In addition, the background information presented by applicant is noted. At page 9, lines 4-12 of the present application applicant states:

"...The angle between the reflected ray and the normal is known as the angle of reflection. The law of reflection states that when a ray of light reflects off a surface, the angle of incidence is equal to the angle of reflection. When a person views an image reflected from the mirror, the light (or image) which travels along the line of sight to one's eye follows the law of reflection. In accordance with one embodiment of the present invention, the light or image reflective material is placed within the vertical surfaces A, B, C of a firebox to obtain optimized viewing of the fireflame through the laws of reflection."

Thus, since each reflective panel of US005469839 (KASULIS et al) displays an image to a viewer that is located within the vertical surfaces, the reflective panels of US005469839 (KASULIS et al) would necessarily and inherently have an angle of incidence and an angle of reflection which are both substantially equal as viewed by a viewer of the systems in the manner set forth in applicant's claims. In regard to claims 2 and 12, for example, the temperature resistant mirrored glass material of US005469839 (KASULIS et al) would necessarily be of the "tempered" glass type since non-tempered glass would not be capable of withstanding thermal expansion and contraction thereof due to thermal cycling of the system. Tempering being a well known process for stabilizing glassware when used in high temperature conditions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 8 and 9: Rejected under 35 U.S.C. 103(a)

Claims 8 and 9 rejected under 35 U.S.C. 103(a) as being unpatentable over US005469839 (KASULIS et al) in view of JP 2003-79507.

US005469839 (KASULIS et al) shows and discloses the invention substantially as set forth in the claims with possible exception to:

- a heat resistant adhesive being adapted to substantially permanently couple the coupling surface to the interior surfaces of the fireplace.

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JP 2003-79507 teaches, form the same flame display field of endeavor as US005469839 (KASULIS et al) coupling mirrors to the interior surface of a chamber body.

In regard to claims 8 and 9, for the purpose substantially permanently coupling the mirror to the fireplace it would have been obvious to a person having ordinary skill in the art to apply and adhesive, have the necessary heat-resistant properties, to the surface to the interior surfaces of the fireplace, in view of the teaching of JP 2003-79507.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Each of JP 10-25927, Nakamura and Fleming show and disclose the use of mirrored surfaces to present reflected flame images.

USPTO CUSTOMER CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARL D. PRICE whose telephone number is (571) 272-4880. The examiner can normally be reached on Monday through Friday between 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ira Lazarus can be reached on (571) 272-4877. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Carl D. Price', with a stylized flourish at the end.

CARL D. PRICE
Primary Examiner
Art Unit 3749

cp